

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed August 25, 2008 and offers the following remarks.

Claims 1-16 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,245,713 B1 to Simpson et al. (hereinafter "Simpson") in view of U.S. Patent No. 6,215,857 B1 to Kasiviswanathan (hereinafter "Kasiviswanathan"). Applicant respectfully traverses.

To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. M.P.E.P. § 2143.03. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. \_\_\_, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Ibid.* If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejections, Applicant provides a brief summary of the claimed invention so that the remarks are considered in the proper context. The claimed invention is designed to facilitate monitoring of a hosted voicemail system. Meaning, even though the hosted voicemail system is not directly associated with any customer device, the user may listen as voice messages are being left in the voicemail system and may interrupt the message to answer the call. The claims are focused on an embodiment wherein the calls are initially directed to the voicemail system and then the telephone terminal is alerted to the existence of the incoming call that the called party may wish to monitor. The voicemail system of a service provider, according to the invention, may be configured to provide the functionality of a conventional answering machine. The user may listen to the voicemail message being left by the caller as the voicemail message is being recorded. At any time during the recording of the voicemail message, the user may engage the call and begin conversing with the caller.

Claim 1 recites a method for allowing call screening in a hosted voicemail system environment comprising:

directing a call to a hosted voicemail system, which serves as a voicemail system for a telephone terminal, wherein the call is initially directed to the hosted voicemail system before being directed to the telephone terminal; and

allowing the telephone terminal to monitor a message being left in the hosted voicemail system.

Claim 1 recites that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal. The combination of Simpson and Kasiviswanathan does not teach this limitation. Simpson shows the opposite situation from the claimed invention. In Simpson, the call is initially directed to the telephone terminal and is only directed to the voicemail system after the call is not answered or the terminal is busy (see Simpson, col. 1, lines 56-63; see also Fig. 2, steps 210, 215, and 220). The Patent Office admits that Simpson does not teach that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal (Office Action mailed August 25, 2008, p. 3). However, the Patent Office asserts that Kasiviswanathan teaches a system where a call is initially directed to a hosted voicemail system before being directed to the telephone terminal. *Ibid.* Applicant respectfully traverses. Kasiviswanathan does not teach or suggest initially directing a call to the hosted voicemail system and **then to the telephone terminal**. Kasiviswanathan discloses that the call is forwarded directly to the voicemail without ringing the called subscriber (Kasiviswanathan, col. 2, lines 64-67; and col. 4, lines 55-58). However, Kasiviswanathan does not teach that the call is initially directed to the voicemail system before being **directed to the telephone terminal**, as recited in the claimed invention. In fact, the whole goal of Kasiviswanathan is to avoid disturbing the called party (Kasiviswanathan, col. 2, lines 64-67). This is the opposite goal of the claimed invention, which initially directs the call to the hosted voicemail system before then directing the call to the telephone terminal to allow the telephone terminal to monitor a message being left in the hosted voicemail system. Due to the teaching in Kasiviswanathan that all calls should be forwarded directly to the voicemail system without ringing the called party, the system of Kasiviswanathan would not allow the telephone terminal of the called party to monitor a message being left in the hosted voicemail system, as is done in the claimed invention. Since Kasiviswanathan only discloses that the call may be forwarded directly to the voicemail system, Kasiviswanathan does not teach or suggest that the call is initially directed to a hosted voicemail system **before being directed to the telephone terminal**, as recited in claim 1. Thus,

Kasiviswanathan does not teach the element for which it is cited. The Patent Office has admitted that Simpson does not teach this element. Thus, it is clear that the combination of Simpson and Kasiviswanathan fails to teach or suggest “directing a call to a hosted voicemail system, which serves as a voicemail system for a telephone terminal, wherein the call is initially directed to the hosted voicemail system **before being directed to the telephone terminal**,” as recited in claim 1. Since the combination does not teach or suggest initially directing a call to a hosted voicemail system and then directing the call to the telephone terminal to facilitate audible call screening in association with a hosted voicemail system, *prima facie* obviousness has not been established. Thus, claim 1 is patentable.

Claims 2-16 depend from claim 1 and recite all the limitations of claim 1. As such, claims 2-16 are patentable for at least the same reasons set forth above with respect to claim 1.

Claim 33 recites similar limitations as those recited in claim 1 and is therefore patentable for at least the same reasons set forth above with respect to claim 1.

In addition, the combination of Simpson and Kasiviswanathan is improper. Simpson discloses a system where calls that are first directed to a telephone terminal are forwarded to a voicemail system and a three-way call between the caller, the called party, and the voicemail system is set up so that the call may be monitored by the called party. Kasiviswanathan teaches away from Simpson and the claimed invention because Kasiviswanathan teaches that all calls should be forwarded directly to the voicemail system without ringing the called party so that the called party is not disturbed. The Patent Office even uses this as the alleged motivation to combine the references, stating it would be obvious to combine the references “for the purpose of providing direct access by the calling party to the voice mail of the called party without disturbing the called party.” (Office Action mailed August 25, 2008, p. 6). Providing direct access to the voicemail such that the called party is not disturbed actually vitiates the purpose of Simpson and the claimed invention to allow the called party to monitor the voicemail message being left. If the call is never directed to the telephone terminal of the called party, it cannot be monitored by the telephone terminal. In fact, Kasiviswanathan recognizes that the direct access to voicemail is a disadvantage because the called party loses control (Kasiviswanathan, col. 1, lines 20-22). Since Simpson is concerned with the called party being able to monitor the call after it is routed to the voicemail system, Kasiviswanathan teaches away from Simpson because Kasiviswanathan teaches that the called party should not be disturbed and the call should never

be directed to the called party (no ringing). Since Kasiviswanathan teaches away from Simpson, the combination of Simpson and Kasiviswanathan is improper. M.P.E.P. § 2141.02; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The combination is further improper because Simpson also teaches away from the claimed invention. Simpson discloses that the call is initially directed to the terminal of the called party, and is only forwarded to the voicemail system if the terminal is busy or does not answer. Thus, Simpson teaches away from the present invention in which the call is initially directed to the hosted voicemail system. Since Simpson teaches away from the present invention, a person of ordinary skill in the art would not combine Simpson and Kasiviswanathan to reach the claimed invention. M.P.E.P. § 2141.02; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). For the above reasons, the proposed combination is improper. Since the combination is improper, the rejection is improper and should be withdrawn.

Claims 17-19 and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Kasiviswanathan and further in view of U.S. Patent Application Publication No. 2004/0096046 A1 to Lektion et al. (hereinafter “Lektion”). Applicant respectfully traverses. The standards for obviousness are set forth above.

As set forth above, the combination of Simpson and Kasiviswanathan is not proper, and therefore the combination of Lektion with Simpson and Kasiviswanathan is also improper. Also, the Patent Office rejected claim 17 for the same reasons that it rejected claim 1. As discussed above, the combination of Simpson and Kasiviswanathan does not teach each and every limitation of claim 1. Lektion does not cure the deficiencies of the combination of Simpson and Kasiviswanathan in this regard. Thus, Applicant respectfully submits that this rejection is improper and should be withdrawn for the reasons set forth above. As such, claim 17, as well as claims 18, 19, and 21-32, which depend from claim 17, define patentable subject matter.

In addition, claims 18, 19, and 21-32 were rejected for the same reasons set forth for claims 2, 3, and 5-16, respectively (see Office Action mailed August 25, 2008, p. 7). Since claims 2, 3, and 5-16 were rejected over Simpson in view of Kasiviswanathan, the Patent Office is using Kasiviswanathan to reject claims 18, 19, and 21-32 as well. As set forth above, the combination of Simpson and Kasiviswanathan does not teach each and every limitation of the

claimed invention. For at least the same reasons, the rejection of claims 18, 19, and 21-32 is improper as well.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III  
Registration No. 39,877  
100 Regency Forest Drive, Suite 160  
Cary, NC 27518  
Telephone: (919) 238-2300

Date: November 25, 2008  
Attorney Docket: 7000-262